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EXAMINER	
HOFFMAN, BRANDON S	
ART UNIT	**PAPER NUMBER**
2136	

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/008,222	BLACK, JONATHAN S.	
	Examiner	Art Unit	
	Brandon Hoffman	2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 February 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *17 February 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claim 1-22 are pending in this office action, claims 14-22 are newly added.

2. Applicant's arguments filed February 17, 2005, have been fully considered but they are not persuasive.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horowitz et al. (WIPO Publication No. 99/01823 A1) in view of Fox et al. (U.S. Patent No. 6,560,581).

Regarding claims 1 and 7, Horowitz et al. teaches a method of purchasing goods or services (via a self service terminal - SST), the method comprising the steps of:

- Encrypting transaction data stored in a first device **under control of a first human party**, the data including security identification information (page 9, lines 10-20 and page 11, lines 11-15);
- **Transferring or copying the encrypted data from the device to the SST [merchant/service provider]** (page 11, lines 21-25);

- **Causing the SST [merchant/service provider] to decrypt the encrypted data, verify the security identification information, and then execute the transaction upon verification** (page 12, lines 6-21).

Horowitz et al. does not teach transferring the encrypted data to a device of a third **human** party; or allowing the third party device to transfer the data to the SST.

Fox et al. teaches transferring the encrypted data to a device of a third **human** party (col. 12, line 35 through col. 13, line 8); and allowing the third party device to transfer the encrypted data to the SST (col. 13, line 60 through col. 14, line 34).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine transferring the encrypted data to a device of a third party, and allowing the third party to transfer the encrypted data to the SST, as taught by Fox et al., with the method of Horowitz et al. It would have been obvious for such modifications because this form of message passing allows the original participant (first party) to pass information to the first recipient (third party) to ultimately be passed to the second recipient (SST). The first recipient is unable to decrypt and interpret the information that is intended for the second recipient. This is desirable because the original participant can send messages to the second recipient via a first recipient in order to take advantage of open-ended communication systems. There is not a need to have proprietary closed-ended communication systems that are more expensive.

Regarding claim 4, Horowitz et al. teaches a method of conducting a transaction via a self service terminal (SST), the method comprising the steps of:

- Receiving encrypted transaction data, the data including security identification information (page 11, lines 15-20);
- Transferring the encrypted data from the **third party** device to an SST (page 11, lines 21-25); and
- **Causing the SST to decrypt the encrypted data, verify the security identification information, and then execute the transaction upon verification** (page 12, lines 6-21).

Horowitz et al. does not teach receiving on a **third party** device encrypted transaction data from a device of a **first** party.

Fox et al. teaches receiving on a **third party** device encrypted transaction data from a device of a **first** party (col. 12, line 35 through col. 13, line 8).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine receiving on a **third party** device encrypted transaction data from a device of a **first** party, as taught by Fox et al., with the method of Horowitz et al. It would have been obvious for such modifications because this form of message passing allows the original participant (first party) to pass information to the first recipient (third party). This is desirable because the original participant can send

messages to the second recipient via a first recipient in order to take advantage of open-ended communication systems. There is not a need to have proprietary closed-ended communication systems that are more expensive.

Regarding claim 5, Horowitz et al. teaches a method of operating a financial service, the method comprising the steps of:

- Providing a user with an encryption key and an identification token for use with a user device (page 12, line 22-25);
- Providing a self service terminal (SST) with a corresponding decryption key (page 12, line 25 through page 13, line 2);
- Accepting encrypted transaction data including the identification token (page 12, lines 3-6);
- Decrypting the transaction data (page 12, lines 6-9);
- Verifying the decrypted identification token (page 12, lines 9-15); and
- Executing the requested transaction (page 12, lines 15-21).

Horowitz et al. does not teach accepting from a device of a third party

Fox et al. teaches accepting from a device of a third party (col. 12, line 35 through col. 13, line 8).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine accepting from a device of a third party, as taught by Fox et al., with the method of Horowitz et al. It would have been obvious for such modifications because this form of message passing allows the first recipient (third party) to pass encrypted data to the second recipient (SST). The first recipient is unable to decrypt and interpret the information that is intended for the second recipient. This is desirable because the original participant can send messages to the second recipient via a first recipient in order to take advantage of open-ended communication systems. There is not a need to have proprietary closed-ended communication systems that are more expensive.

Regarding claim 6, Horowitz et al. teaches a method of using a financial service, the method comprising the steps of:

- Using a device **in possession of a first party, encrypting** transaction data and an identification token **using** an encryption key (page 9, lines 10-20 and page 11, lines 11-15); and
- Presenting the encrypted data to a financial service operator (page 11, lines 21-25).

Horowitz et al. does not teach presenting via a device of a third party.

Fox et al. teaches presenting via a device of a third party (col. 13, line 60 through col. 14, line 34).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine presenting via a device of a third party, as taught by Fox et al., with the method of Horowitz et al. It would have been obvious for such modifications because this form of message passing allows the first recipient (third party) to pass encrypted data to the second recipient (SST). The first recipient is unable to decrypt and interpret the information that is intended for the second recipient. This is desirable because the original participant can send messages to the second recipient via a first recipient in order to take advantage of open-ended communication systems. There is not a need to have proprietary closed-ended communication systems that are more expensive.

Regarding claims 8, 10, and 12, Horowitz et al. teaches a method of operating an automated teller machine (ATM) [retail facility] to allow an ATM [retail] customer to carry out a desired financial [retail] transaction through a device operated by a third party, the method comprising the steps of:

- Receiving encrypted transaction data including security identification information (page 11, lines 15-20);
- Decrypting the encrypted transaction data including security identification information received from the third party device (page 12, lines 6-9);
- Verifying the security identification information received from the third party device (page 12, lines 9-15); and

- Executing the desired financial [retail] transaction of the ATM [retail] customer based upon the decrypted transaction data and the verified security identification information received from the third party device (page 12, lines 15-21).

Horowitz et al. does not teach receiving encrypted transaction data including security identification information from the third party device which has received the encrypted transaction data from a device operated by the ATM [retail] customer.

Fox et al. teaches receiving encrypted transaction data including security identification information from the third party device which has received the encrypted transaction data from a device operated by the ATM [retail] customer (col. 12, line 35 through col. 13, line 8 and col. 13, line 60 through col. 14, line 34).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine receiving encrypted transaction data from the third party device which has received the encrypted transaction data from a device operated by the ATM customer, as taught by Fox et al., with the method of Horowitz et al. It would have been obvious for such modifications because this form of message passing allows the original participant (first party) to pass information to the first recipient (third party) to ultimately be passed to the second recipient (SST). The first recipient is unable to decrypt and interpret the information that is intended for the second recipient. This is desirable because the original participant can send messages to the second

recipient via a first recipient in order to take advantage of open-ended communication systems. There is not a need to have proprietary closed-ended communication systems that are more expensive.

Regarding claim 17, Horowitz et al. teaches a method, comprising:

- Maintaining a PIN in storage in a user's personal computing device A (page 11, lines 11-14);
- Entering a dollar amount into the user's personal computing device A (page 11, lines 11-14);
- Encrypting the dollar amount and the PIN to produce encrypted data (page 11, lines 14-20);
- Transferring the encrypted data from the other computing device B to a self-service terminal, SST (page 11, line 21 through col. 12, line 6); and
- Causing the SST, or a related system, to evaluate the PIN in the encrypted data, and the PIN is valid, executing a transaction involving the dollar amount (page 12, lines 6-21).

Horowitz et al. does not teach transferring the encrypted data to another computing device B from device A.

Fox et al. teaches transferring the encrypted data to another computing device B from device A (col. 12, line 35 through col. 13, line 8).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine transferring the encrypted data to another computing device B from device A, as taught by Fox et al., with the method of Horowitz et al. It would have been obvious for such modifications because this form of message passing allows the original participant (first party) to pass information to the first recipient (third party). This is desirable because the original participant can send messages to the second recipient via a first recipient in order to take advantage of open-ended communication systems. There is not a need to have proprietary closed-ended communication systems that are more expensive (see col. 2, lines 3-7 of Fox et al.).

Regarding claim 19, Horowitz et al. teaches in a process of obtaining currency from an ATM which requires a PIN to dispense currency, a method of delivering a PIN to the ATM, comprising:

- Encrypting a currency amount and a PIN into a packet of encrypted data (page 11, lines 14-20).

Horowitz et al. does not teach delivering the packet to a party who does not know the PIN, and has no access to the PIN.

Fox et al. teaches delivering the packet to a party who does not know the PIN, and has no access to the PIN (col. 12, line 35 through col. 13, line 8).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine delivering the packet to a party who does not know the PIN, and has no access to the PIN, as taught by Fox et al., with the method of Horowitz et al. It would have been obvious for such modifications because this form of message passing allows the original participant (first party) to pass information to the first recipient (third party). The first recipient is unable to decrypt and interpret the information that is intended for the second recipient. This is desirable because the original participant can send messages to the second recipient via a first recipient in order to take advantage of open-ended communication systems. There is not a need to have proprietary closed-ended communication systems that are more expensive.

Regarding claim 21, Horowitz et al. teaches a method, comprising:

- Receiving, from a person at an ATM, an encrypted data packet which contains (1) a currency amount and (2) a PIN (page 11, line 14 through page 12, line 6).

Horowitz et al. does not teach without receiving a PIN from the person for confirmation, determining if the encrypted PIN is valid, and, if so, dispensing currency to the person.

Fox et al. without receiving a PIN from the person for confirmation, determining if the encrypted PIN is valid, and, if so, dispensing currency to the person (col. 13, line 60 through col. 14, line 34).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine receiving a PIN from the person for confirmation, determining if the encrypted PIN is valid, and, if so, dispensing currency to the person, as taught by Fox et al., with the method of Horowitz et al. It would have been obvious for such modifications because this form of message passing allows the first recipient (third party) to pass encrypted data to the second recipient (SST). The first recipient is unable to decrypt and interpret the information that is intended for the second recipient. This is desirable because the original participant can send messages to the second recipient via a first recipient in order to take advantage of open-ended communication systems. There is not a need to have proprietary closed-ended communication systems that are more expensive (see col. 2, lines 3-7 of Fox et al.).

Regarding claims 2, 9, 11, and 13, the combination of Horowitz et al. in view of Fox et al. teaches further comprising the step of transferring transaction (financial/retail) confirmation data from the SST to the third party (see page 12, lines 9-15 of Horowitz et al.).

Regarding claim 3, the combination of Horowitz et al. in view of Fox et al. teaches further comprising the step of including data determining which third party is permitted to transfer the data to the SST (see col. 13, lines 49-51 of Fox et al.).

Regarding claim 14, the combination of Horowitz et al. in view of Fox et al. teaches wherein the first device is portable, and is personal property of the first party (see page 10, lines 1-2 of Horowitz et al.).

Regarding claim 15, the combination of Horowitz et al. in view of Fox et al. teaches wherein none of the data security information is made available to, nor known by, the third party (see col. 13, lines 51-59 of Fox et al.).

Regarding claim 16, the combination of Horowitz et al. in view of Fox et al. teaches wherein the transaction data, after encryption, is transferred to the device of the third party, prior to the step of presenting the encrypted data to a financial service operator (see col. 12, line 66 through col. 13, line 8 of Fox et al.).

Regarding claim 18, the combination of Horowitz et al. in view of Fox et al. teaches wherein the transaction comprises dispensing currency by the SST (see page 11, lines 23-24 of Horowitz et al.).

Regarding claim 20, the combination of Horowitz et al. in view of Fox et al. teaches further comprising delivering the packet to the ATM (see page 11, lines 24-25 of Horowitz et al.).

Regarding claim 22, the combination of Horowitz et al. in view of Fox et al. teaches wherein the currency dispensed is substantially equal to the currency amount (see page 11, lines 23-24 of Horowitz et al.).

Response to Arguments

5. Applicant amends claims 1, 4, 6, and 7.

6. Applicant's arguments are moot in view of the new grounds of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon Hoffman whose telephone number is 571-272-3863. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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